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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/577,869	06/23/2006	Giovanni Cotticelli	59130-8012.US01	6768
22918	7590	03/14/2008		
PERKINS COIE LLP			EXAMINER	
P.O. BOX 2168			CHANDRAKUMAR, NIZAL S	
MENLO PARK, CA 94026				
		ART UNIT	PAPER NUMBER	
		1625		
		MAIL DATE	DELIVERY MODE	
		03/14/2008	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/577,869

**Applicant(s)**

COTTICELLI ET AL.

**Examiner**

NIZAL S. CHANDRAKUMAR

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10, 16-22, 24, 26 and 27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 16-22, 24, 26-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

Applicants response filed 02/12/2008 is acknowledged.

Following entry of the amendments, claims 1-10, 16-22, 24 and 26-27 are pending.

**Response to Applicants Remarks:**

***Claim Rejections - 35 USC § 112***

Applicant's amendments to claims overcome the previously presented rejection under 35 USC § 112 (second paragraph).

***Claim Rejections - 35 USC § 101***

Applicants amendments to claims overcome the previously presented rejection under 35 USC § 101.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Applicant's amendments to claims partially overcome the previously presented rejection under 35 USC § 112 (First paragraph). Rejection with respect to claims 24, and 26 pertaining to structure of claimed magnesium alkoxide is maintained for reasons of record. Applicants point out the Note 1 on page 7, as reasonable evidence of structure. This is not found to be persuasive because, it is well known in the art that tert.alkoxides are more basic than primary alkoxides. Thus, even if the indicated structure is initially formed, it would eventually form the other possible magnesium alkoxide. This assumes that the two discrete alkoxides are formed initially and there was source for one equivalent of H<sup>+</sup>. Further it is well known in the art, that such organometallic alkoxides form aggregates and not discrete defined structures such as the one shown in claim 24.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The previously presented rejections of claims as being unpatentable over Bosgeso et al. (EP 0171943 A1) and US 4943590, is maintained for reasons of record.

Applicants argue that the cited reference relate to

**methods requiring discrete reaction steps for forming an intermediate and then affecting cyclization on the isolated intermediate.**

and the pending claims of recite a process wherein an intermediate is not isolated. Applicants also state that there is nothing in the cited references to modify the process to arrive at the claimed process, And that the Examiner has not presented a secondary reference to correct this defect in the cited reference.

This is not persuasive because, for example, as in the process of Bosgeso et al., the extract after the first step in which the diol is formed is used without purification in the next step of acid catalyzed cyclization. Further as the court said in *In re Fortess*, "Process claims are refused since process is an obvious combination of two processing steps, each lending to end products the desirable properties each is known to produce when practiced alone, there being no evidence of a coaction between steps that produces unexpected results; one of ordinary skill in the art, having references before him, would perceive benefits of combination, without recourse to applicants' specification; no other combination of references can be made". *In re Fortess* (CCPA 1966) 369 F2d 1009, 152 USPQ 13. The yield of the final HBr salt of the product obtained in the process of the prior art and the instantly claimed process are

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the same, with the prior art providing a slightly higher yield. Applicant has not shown unexpected results in the instant process.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NIZAL S. CHANDRAKUMAR whose telephone number is (571)272-6202. The examiner can normally be reached on 8.30 AM - 4.30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571 0272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Nizal S. Chandrakumar

/D. Margaret Seaman/  
Primary Examiner, Art Unit 1625